



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SETTE *et al.*

Appl. No.: 09/412,863

Filed: October 5, 1999

For: **Inducing Cellular Immune  
Responses to Human  
Immunodeficiency Virus-1 Using  
Peptide and Nucleic Acid  
Compositions**

Confirmation No.: 1200

Art Unit: 1644

Examiner: Schwadron, R.B.

Atty. Docket: 2060.0040005/HCC/VSR

**Reply to Requirement For Election of Species**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated May 11, 2004 requesting several elections of species to prosecute in the above-referenced application, Applicants hereby provisionally elect the species listed below. These elections are made without prejudice to or disclaimer of the other claims or inventions disclosed.

In the first requirement, election between peptides of 9, 10 or 11 amino acids which contain the peptide AIFQSSMTK was required. Applicants hereby provisionally elect: a peptide that is 9 amino acids and contains the peptide AIFQSSMTK. Claims 108 and 111-128 read on the elected species. This election is made **with traverse**. Applicants note that the peptides of 9, 10 or 11 amino acids listed above *share the same nine amino acid sequence AIFQSSMTK*. Applicants submit that the addition of one or two amino acids to said nine amino sequence would not create an undue burden for searching and examining, as the same sequence would be used for the basis of such a

search for all peptides. Applicants respectfully request that this requirement be withdrawn.

In the second requirement, the Examiner required election between various types of molecules. In response, Applicants provisionally elect: d) a peptide fused to a linker. Claims 108, 111, 113, 119-120, 122-123, 125-126 and 128 read on the elected species. This election is made **with traverse**. Applicants submit that the claimed invention is directed to peptides or compositions all of which comprise *the identically claimed peptide*. Applicants assert that examining species which comprise the same claimed peptide would not create an undue burden for searching and examining. In addition, claims to be restricted to different species must recite the mutually exclusive characteristics of such species. MPEP 806.04(f). In the present case, as an example, species (d) a peptide fused to a linker is not mutually exclusive of species (b) a peptide/liposome. Thus, restriction to one species in this case is improper. Similarly, species (a) - (h) are not necessarily mutually exclusive. Accordingly, Applicants respectfully request that requirement be withdrawn.

Finally, Applicants note that the Examiner listed claims 71-265 as pending on the Office Action Summary of the outstanding Office Action. For the sake of clarity, Applicants would like to draw the Examiner to the Fourth Preliminary Amendment filed June 21, 2002, in which claims 90-107, 129-146, 165-182, 203-214, 235-240, and 260-265 were cancelled. Entry of this Preliminary Amendment and notice to that effect is respectfully requested.

Reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, are respectfully requested.

It is believed that extensions of time are not required, beyond those that may otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: June 2, 2004

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June 2, 2004

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**Art Unit 1644**

Re: U.S. Utility Patent Application  
Application No. 09/412,863; Filed: October 5, 1999  
For: **Inducing Cellular Immune Responses to Human Immunodeficiency  
Virus-1 Using Peptide and Nucleic Acid Compositions**  
Inventors: SETTE *et al.*  
Our Ref: 2060.0040005/HCC/VSR

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Requirement For Election of Species; and
2. Return postcard.

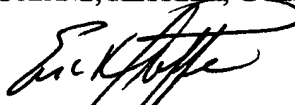
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
June 2, 2004  
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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Eric K. Steffe", written over the printed name.

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EKS/VSR:amr  
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